

I. REMARKS

The Examiner's rejection under 35 U.S.C. § 103(a) is untenable because U.S. Patent Application Publication No. US 2004/0047242 (hereafter, the "Germiquet Publication") is not valid prior art for the purposes of determining patentability under this section in view of 35 U.S.C. § 103(c) because the present application and the Germiquet Publication were "commonly owned" by The Swatch Group Ltd. at the time the present invention was made.

Specifically, the Germiquet Publication was published on March 11, 2004, and corresponds to U.S. Patent Application No. 10/649,718, filed August 28, 2003. The present application was filed September 26, 2005 as the U.S. National Phase Application of International Patent Application No. PCT/EP2005/002165 filed March 2, 2005, which claims priority on European Patent Application No. 04100859.0, filed March 3, 2004. The Examiner has already acknowledged receipt from the International Bureau of copies of the certified copy of Applicants' foreign priority document, European Patent Application No. 04100859.0 (See Office Action, dated April 21, 2008, Office Action Summary, Section 12). Filed herewith is a certified English translation of the European Patent Application No. 04100859.0. Therefore, Applicants have perfected their claim for foreign priority in accordance with MPEP § 201.15.

In view of the above facts, the present invention enjoys a priority date of March 3, 2004. In view of this fact, the Germiquet Publication is valid prior art under only 35 U.S.C. § 102(e). In addition, the Germiquet Publication was completely owned by, or subject to an obligation of assignment to, ASULAB, S.A., at the time the present invention was made (i.e., the subject matter of the Germiquet Publication was 100% owned by ASULAB, S.A. at the time the present invention was made). The present invention was completely owned by, or subject to an obligation of assignment to, ETA SA Manufacture Horlogère Suisse, at the time

the present invention was made (i.e., the subject matter of the present application was 100% owned by ETA SA Manufacture Horlogère Suisse at the time the present invention was made). However, both ASULAB, S.A. and ETA SA Manufacture Horlogère Suisse are wholly owned subsidiaries of The Swatch Group, Ltd., and were wholly owned by The Swatch Group, Ltd. at the time the present invention was made (i.e., The Swatch Group Ltd. owned 100% of both ASULAB, S.A. and ETA SA Manufacture Horlogère Suisse at the time the present invention was made).

In view of the above facts, the present invention and the subject matter of the Germiquet Publication were “owned by the same person or subject to an obligation of assignment to the same person” (i.e., were “commonly owned”) in accordance with 35 U.S.C. § 103(c). Therefore, the Germiquet Publication is not valid prior art for the purposes of accessing patentability under 35 U.S.C. § 103. See 35 U.S.C. § 103 and MPEP § 706.02(I)(2).

A. The Rejections

Claims 23, 25 and 27-43 stand rejected under 35 U.S.C. §103(a) as unpatentable over Plancon et al. (US Patent 7,113,450, hereafter the “Plancon Patent”) in view of Germiquet et al. (U.S. Patent Application Publication No. US 2004/0047242, the Germiquet Publication).

Applicants respectfully traverse the Examiner’s rejection and request reconsideration of the above-captioned application because the Germiquet Publication is not valid prior art.

B. Applicants’ Arguments

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining

the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In this case, the Examiner has failed to establish a prima facie case of obviousness against the claimed invention because the Plancon Patent fails to teach each and every limitation of the claimed invention and the Germiquet Publication is not valid prior art for the purposes of determining patentability under 35 U.S.C. § 103.

i. The Plancon Patent

The Plancon Patent discloses a “wearable electronic device with multiple display functionality” as shown in Figure 1. However, as admitted by the Examiner (Office Action, dated April 21, 2008, at 3, lines 20-22), the Plancon Patent does not teach, or suggest, “first and second analogue display members, wherein the analogue display members are arranged above the dial to display current time in a time mode which is a first operating mode” and “said first analogue display member indicates, opposite suitable graduations of the watch, the value of a variable the change in which is linked to physical magnitude value, on condition that the variable does not give any indication relating to the time remaining before a decompression stop has to be made or any indication relating to a minimum depth not to be exceeded by a person wearing the watch when coming up from a dive when said second analogue display member is made to indicate information relating to a depth” as recited by independent claims 23, 27 and 28.

ii. The Germiquet Publication

The Germiquet Publication discloses an “electronic diving watch with analog display.” However, for all of the reasons discussed above, the Germiquet Publication is not valid prior art for the purposes of determining patentability under 35 U.S.C. § 103(a).

Therefore, no further comments regarding this publication is believed to be necessary at this time.

II. CONCLUSION


The Examiner has failed to establish a prima facie case of obviousness against independent claims 23, 27 and 28 based on the combination of the Plancon Patent and the Germiquet Publication because the Germiquet Publication is not valid prior art for the purposes of determining patentability under 35 U.S.C. § 103(a) because the presently claimed invention and the Germiquet Publication were commonly owned by The Swatch Group Ltd. at the time the present invention was made.

For the reasons stated above, claims 23, 25, and 27-43 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

The below-signed attorney for applicant welcomes any questions.

Respectfully submitted,

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